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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,315	03/20/2001	Sean E. Carolan	2000-0296	2923

7590 06/23/2004  
Samuel H. Dworetsky  
AT&T CORP.  
P.O. Box 4110  
Middletown, NJ 07748-4110

EXAMINER

FLEMING, FRITZ M

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/812,315

Applicant(s)

CAROLAN ET AL.

Examiner

Fritz M Fleming

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.


- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

  
FRITZ FLEMING  
PRIMARY EXAMINER  
GROUP 1

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3, copies enclosed
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no clear antecedent basis for the claim 11/12 "of the selected service provider", as, most likely, reference should be made to "second".

### ***Specification***

3. The disclosure is objected to because of the following informalities: The reference to "Fig. 5" on page 15, line 13, should most likely be to "Fig. 6".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Sistanizadeh et al. (Sistanizadeh).

To anticipate claims 1-12, attention is brought to Figures 3 and 5 and 8/8a/8b. For example, Figure 3 shows the users at 316-324 as the subscribers/network access

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devices, as does Figure 5 at 510/512. Service providers with different address pools are seen at 340/342, as well as (AS)UUNET 101.211.0.0 and (AS)PSI 164.109.0.0 of Figure 5. The access network, analogous to applicants' 120/221/225, is seen as the 310-314,328,330 which then in turn connects the subscribers to the service providers. Turning to Figures 8a/b, such are the same as applicants' Figures 4 and 5, as far as providing the same functionality as claimed. For claims 1-7, note the use of USER 810, PC/Client 812, DHCP server 814, DNS 816, ISP/IP 818 and the initial boot and request leading up to the start of an application. Eventually, the user does a "Change ISP Different Username & Password" which is detailed as the "fourth stage" of column 13, lines 12-27, in which the user desires a change to a new ISP via clicking on the ISP change application, with an initial DHCPRELEASE and a DHCPDISCOVER to request a change from the user, with a DHCPOFFER being the response from the access network, ultimately leading to DHCPREQUEST and DHCPACK to finalize the switch to the second ISP, with its second pool of addresses so that data packets can be transmitted to/from the user and the second ISP. Note the use of the DHCP protocol throughout this procedure. Note that an authentication request for the subscriber is in the form of the user providing the new user name and password for the ISP change, wherein the change can only take place if such is authenticated, as per column 13, lines 28-55 which discuss the public key/private key. Per Figure 5, the ultimate user address is in the IP format. As far as claim 6 is concerned, the user at the PC/client uses applications to select the initial ISP username and password, and then to use it to select the new ISP to which the change is desired. This anticipates the plurality of server

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choices displayed to enable a selection, to the extent claimed, as the claim does not specify a particular display layout. As far as claims 8-12 are concerned, the authentication from the user to the access network is in the form of the public/private keys as well as the use of a user name and password which require proper authentication for the process to be validated and proceed to the desired completion. For example, if the user name and password are not correct, there will be no authentication provided for the DHCP process to continue the network address change.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-12;1,4-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6;12 of copending Application No. 09/812,313 (Carolan et al. US2001/0049737); 09/812,442 (Carolan et al. US2002/0036658). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims, as well as the copending claims, all embrace the method of configuring a network access device to a

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second service provider from a first service provider, using DHCP, as well as the use of authentication.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The "AT&T Broadband to Launch..." discloses the use of a "service agent" as a special software package to select one or more ISPs. "Automated Configuration..." discloses the well known use of DHCP Messages, as well as authentication. "DHCP for Ipv6" teaches the well-known aspects of DHCP configuration parameters, addressing security in 6. RFC1541 and 2131 detail DHCP. WO 98/26554 discusses the use of trusted identifiers. Mouko et al. show DHCP details. Nassar shows plural service providers. Akgun et al. teach DHCP details. Lager et al. teach multiple ISPs, as do Johnson et al. Brewer et al. show a selection display at Figure 4, with a change in IP settings. Monachello et al. teach dynamic selection of a network service provider. Demirtjis et al. teach a DHCP server 86 and a connection server 110. Short et al. teach the use of a DHCP server 24 in conjunction with network transparency. Schmuelling et al. teach ISP selection with an ISP list (Figure 5). Sitaraman et al. teach the use of RADIUS. Bhatia et al. teach an ISP WIZARD. Daizo teaches the use of DHCP servers 11/21 with different IP addresses. Gupta et al. teach

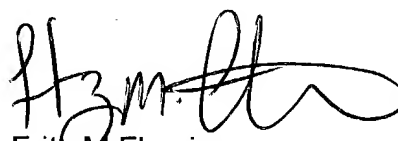
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a DHCP release sequence in Figure 9. Ford et al. teach IP address creation. Lim et al. teach the use of a DHCPNAK. Carolan et al. 2001/0049729 is the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fritz M Fleming whose telephone number is 703-308-1483. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-1483. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Fritz M Fleming  
Primary Examiner  
Art Unit 2182

fmf